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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,065	03/30/2000	MARC DOLATKHANI	BIF103705/US	3112

7590 05/09/2002

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/486,065

Applicant(s)

Dolatkhani et al.

Examiner

Brian Pellegrino

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 13, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-63 is/are pending in the application.
- 4a) Of the above, claim(s) 44-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 19-43 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Feb 13, 2002 is: ☒ approved ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. .
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). .
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 20) ☐ Other: .

Art Unit: 3738

## DETAILED ACTION

### *Election/Restriction*

1. Newly submitted claims 44-63 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new process claims are solely directed to a process or manufacturing method of which was not claimed separately before. The original claims were dependent on a product or article claim.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 44-63 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Claim Rejections - 35 U.S.C. § 102*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 19-21,23,24,27-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Vanderbilt (5326506). Vanderbilt discloses a soft optical part and a rigid haptic part, col. 3, lines 45-52 and col. 5, lines 39-42. Regarding claims 21,23,24,33 see col. 5, lines 59-68 and col. 6, lines 52-54. With respect to claims 28-31, see col.7, lines 61-68 and col. 8, lines 1-12 suggesting

Art Unit: 3738

that a "zone" can be established to join the two parts of rigid material and flexible material. Fig. 3 shows element 46 which can be construed as an attachment member.

4. Claims 19-23,26-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Bos et al. (5762836). See claims. Bos et al. disclose that the flexible material can be hydrophilic, col. 11, lines 24-29. Bos et al. also disclose that polymer materials, such as polydimethylsiloxanes are suitable for the intraocular lens, col. 12, lines 32-34.

***Claim Rejections - 35 U.S.C. § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 25,36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanderbilt '506 in view of Freeman et al. (5693095). Vanderbilt is explained supra. Vanderbilt does disclose that crosslinking agents are added in the materials, col. 4, lines 12-15. However, Vanderbilt does not disclose the use of the polyfunctional agent diethylene glycol dimethacrylate. Freeman et al. teach the use of diethylene glycol dimethacrylate for crosslinking copolymers, col. 3, lines 3-15. It would have been obvious to one of ordinary skill in the art at the time of the invention to use an alternative crosslinking agent such as diethylene glycol dimethacrylate as taught by Freeman for crosslinking copolymer materials of Vanderbilt, in order to affect the rate of reaction.

Art Unit: 3738

7. Claims 34, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanderbilt '506 in view of Sherr et al. (3391224). Vanderbilt is explained supra. Vanderbilt does disclose that crosslinking agents are added in the materials, col. 4, lines 12-15. However, Vanderbilt does not disclose the agent used in crosslinking as monofunctional. Sherr et al. teach that a monofunctional agent, i.e. styrene is used in a polymerization reaction to aid in forming a thermosetting composition. It would have been obvious to one of ordinary skill in the art at the time of the invention to use an monofunctional agent in crosslinking to increase the stability and formability of the intraocular lens.

8. Claims 36-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanderbilt '506 in view of Wang et al. (6011082). Vanderbilt is explained supra. Vanderbilt does disclose that crosslinking agents are added in the materials, col. 4, lines 12-15. However, Vanderbilt does not disclose the agent used in crosslinking as polyfunctional. Wang et al. teach to use a coupling agent in the polymerization process of copolymers to provide a surface modification with long-term stability. Wang also teaches that the reaction is done with a polyfunctional agent, col. 5, lines 1-7. It would have been obvious to one of ordinary skill in the art to use a polyfunctional agent in the modification of the material to stabilize it. As a result this will enhance the longevity of the prosthesis.

Art Unit: 3738

*Response to Arguments*

9. Applicant's arguments filed 2/13/02 have been fully considered but they are not persuasive. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3.

*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3738

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


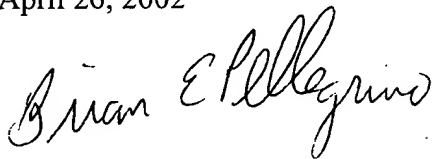
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino

April 26, 2002



Paul Prebilic  
Primary Examiner  
TC 3700, AU 3738

**Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.